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Filing date: **06/11/2020**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**Petition for Cancellation**

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

**Petitioner Information**

Name	Imagineer Co., Ltd.		
Entity	limited company	Citizenship	Japan
Address	7-1 NISHI-SHINJUKU 2-CHOME SHINJUKU-KU TOKYO, 163-0715 JAPAN		
Attorney information	DREW M. SMITH HOLLEY & MENKER, PA P.O. BOX 1650 BEND, OR 97709 UNITED STATES Primary Email: eastdocket@holleymenker.com, dsmith@holleymenker.com 720-289-2300		

**Registration Subject to Cancellation**

Registration No.	5999237	Registration date	03/03/2020
International Registration No.	NONE	International Registration Date	NONE
Registrant	Kevin ComadrÃn De Frutos AVENIDA DE LAS NACIONES UNIDAS 17, 3Âº 1Âª 700 ESCALDES-ENGORDANY ANDORRA		

**Goods/Services Subject to Cancellation**


<p>Class 009. First Use: 0 First Use In Commerce: 0</p> <p>All goods and services in the class are subject to cancellation, namely: Downloadable video game programs for consumer video game apparatus; Downloadable video game programs for hand-held gameapparatus with liquid crystal displays;Downloadable video game programs for handheld game apparatus with liquid crystal displays; Downloadable video game programs for video game machines; downloadable video game programs and additional downloadable electronic data files for consumer video game apparatus; downloadablevideo game programs and additional downloadable electronic data files for playing games on arcade video game machines; downloadable video game programs and additional data for hand-held games with liquid crystal displays; downloadable computer game programs and additional data for computers; downloadable video game programs and additional downloadable electronic data files for playing games on mobile phones; downloadable programs for operating mobile phones; downloadable gaming video game programs for cellular phones</p>
<p>Class 041. First Use: 0 First Use In Commerce: 0</p> <p>All goods and services in the class are subject to cancellation, namely: Providing a website featuring on-line non-downloadable music and sound files for use with consumer video game apparatus;</p>

providing a website featuring on-line non-downloadable music and sound files for use with cellular phones; providing a website featuring on-line non-downloadable music and sound files; providing a website featuring on-line non-downloadable music and sound files for use with handheld game apparatus with liquid crystal displays; providing a website featuring on-line non-downloadable music and sound files for use with video game machines; providing a website featuring on-line non-downloadable game software; providing a website featuring on-line non-downloadable game software for video game apparatus; providing a website featuring on-line non-downloadable game software for handheld game apparatus with liquid crystal displays and games for cellular phones

## Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Dilution by blurring	Trademark Act Sections 14(1) and 43(c)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute	Trademark Act Sections 14(3) and 2(a)

## Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	88944349	Application Date	06/02/2020
Registration Date	NONE	Foreign Priority Date	05/26/2020
Word Mark	MEDAROT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 Computers; computer peripheral devices; recorded computer programs; encoded magnetic cards; recorded computer game software; downloadable computer game software; game programs for home video game machines; electronic circuits and CD-ROMs recorded with programs for hand-held games with liquid crystal displays; phonograph records; EP records; sound recorded magnetic cards, sheets and tapes; recorded audio compact discs; downloadable music files; downloadable image files; recorded video discs and video tapes; application software for smartphones; downloadable applications for use with mobile devices</p> <p>Class 041. First use: First Use: 0 First Use In Commerce: 0 Electronic games services provided by means of the Internet; information relating to electronic games services provided by means of the Internet; on-line game services provided by means of the Internet or computer network; information relating to on-line game services provided by means of the Internet or computer network; providing on-line computer games; information relating to on-line com-</p>		

	puter games; providing amusement facilities; providing on-line games for smart-phones; information relating to on-line games for smartphones
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U.S. Application/ Registra- tion No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	MEDAROT		
Goods/Services	recorded computer programs; computer game software; game pro-grams for home video game machines; electronic games services provided by means of the Internet; information relating to electronic games services provided by means of the Internet; providing on-line computer games; providing information relating to online-computer games; production of television programs; development and produc-tion of animated television programs		

U.S. Application/ Registra- tion No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	MEDABOTS		
Goods/Services	recorded computer programs; computer game software; game pro-grams for home video game machines; electronic games services provided by means of the Internet; information relating to electronic games services provided by means of the Internet; providing on-line computer games; providing information relating to online-computer games		

U.S. Application/ Registra- tion No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	MEDABOTS AX		
Goods/Services	recorded computer programs; computer game software; game pro-grams for home video game machines; electronic games services provided by means of the Internet; information relating to electronic games services provided by means of the Internet; providing on-line computer games; providing information relating to online-computer games		

U.S. Application/ Registra- tion No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	MEDABOTS INFINITY		
Goods/Services	recorded computer programs; computer game software; game pro-grams for home video game machines; electronic games services provided by means of the Internet; information relating to electronic games services provided by means of the Internet; providing on-line computer games; providing information relating to online-computer games		

Attachments	88944349#TMSN.png( bytes ) Petition to Cancel US RN 59999237 - MEDABOTS .pdf(953773 bytes )
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Signature	/Drew M. Smith/
Name	Drew M. Smith

Date	06/11/2020
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL APPEAL BOARD**

Imagineer Co., Ltd.,	)	
	)	
Petitioner,	)	
	)	
v.	)	Registration No. 5999237
	)	
Kevin Comadrán De Frutos,	)	
	)	
Respondent.	)	

**PETITION TO CANCEL**

Imagineer Co., Ltd. (“Petitioner”) is or will be damaged by the continued registration of the mark MEDABOTS, which is set forth in registration no. 5999237 and owned by Kevin Comadrán De Frutos (“Respondent”), and hereby requests cancellation of the same.

As grounds for its Petition to Cancel, Petitioner, by its attorneys, avers as follows:

1. Petitioner engages in the business of developing and publishing video game programs for gaming devices developed and sold by Nintendo Co., Ltd. (“Nintendo”), among others.

2. Commencing on or about November 28, 1997, Petitioner developed and released a video game under the mark MEDAROT for Nintendo’s Game Boy handheld gaming device. Petitioner released the MEDAROT video game in the Japanese market, however, the series of MEDAROT video games have since become well known in other countries including, but not limited to, the United States. At all relevant times between November 28, 1997 and present, Petitioner has continued to develop and publish MEDAROT video games that garner a widespread following amongst consumers in the United States, and in other countries.

3. Since the first MEDAROT video game was released, Petitioner has expanded its use of the MEDAROT mark to include other goods and services, as exemplified by Petitioner’s

development and production of an animated television series based on the MEDAROT video game which has been translated and broadcast to consumers in numerous countries, including the United States.

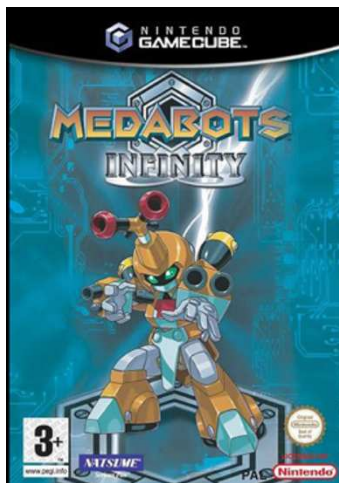
4. Based on the success of Petitioner's MEDAROT video game, Petitioner and its licensees, Natsume Co. Ltd. ("Natsume") and Kodansha Ltd. ("Kodansha"), developed a second role-playing video game to further commercialize Petitioner's products outside of the Japanese market. Petitioner adopted the mark MEDABOTS for its video game programs in foreign markets, such as in Europe and the United States, for the video game series previously released and remaining available since as early as November 28, 1997.

5. On or about June 25, 2002, Petitioner commenced offering for sale its MEDABOTS video game programs to consumers residing in the United States when it released MEDABOTS AX (available in two versions Metabee and Rokusho) for the Nintendo's Game Boy Advance hand-held gaming device.

6. On or about March 31, 2003, Petitioner released a second MEDABOTS video game to consumers in the United States. Petitioner's second video game, entitled MEDABOTS, for Nintendo's Game Boy Advance handheld gaming device was available in two versions (Metabee and Rokusho) and featured the packaging artwork displayed below:



7. On or about December 14, 2003, Petitioner released a third version of its MEDABOTS video game to consumers in the United States, MEDABOTS INFINITY, for Nintendo's GameCube console gaming device and featuring the packaging artwork displayed below:



8. On or about December 10, 2015, Petitioner re-released its MEDABOTS video game to consumers in the United States for Nintendo's Wii U Virtual Console gaming device, available in both Metabee and Rokusho versions.

9. On or about February 25, 2016, Petitioner re-released its MEDABOTS AX video game to consumers in the United States for Nintendo's Wii U Virtual Console gaming device, available in both Metabee and Rokusho versions.

10. Petitioner, and its licensees, have used Petitioner's MEDABOTS, MEDABOTS AX, and MEDABOTS INFINITY (collectively Petitioner's MEDABOTS Marks) on video game programs sold and distributed in United States commerce at all relevant times between June 25, 2002 and present.

11. On February 28, 2018, Respondent filed application serial no. 79260030 with the US PTO seeking to register the mark MEDABOTS for "providing a website featuring on-line non-downloadable music and sound files for use with consumer video game apparatus; providing a

website featuring on-line non-downloadable music and sound files for use with cellular phones; providing a website featuring on-line non-downloadable music and sound files; providing a website featuring on-line non-downloadable music and sound files for use with handheld game apparatus with liquid crystal displays; providing a website featuring on-line non-downloadable music and sound files for use with video game machines; providing a website featuring on-line non-downloadable game software; providing a website featuring on-line non-downloadable game software for video game apparatus; providing a website featuring on-line non-downloadable game software for handheld game apparatus with liquid crystal displays and games for cellular phones” in International Class 9 and for “downloadable video game programs for consumer video game apparatus; downloadable video game programs for hand-held game apparatus with liquid crystal displays; downloadable video game programs for video game machines; downloadable video game programs and additional downloadable electronic data files for consumer video game apparatus; downloadable video game programs and additional downloadable electronic data files for playing games on arcade video game machines; downloadable video game programs and additional data for hand-held games with liquid crystal displays; downloadable computer game programs and additional data for computers; downloadable video game programs and additional downloadable electronic data files for playing games on mobile phones; downloadable programs for operating mobile phones; downloadable gaming video game programs for cellular phones” in International Class 41.

12. Application serial no. 79260030 was filed under Section 66(a) of the Trademark Act based on Respondent’s intention to rely on the February 28, 2018 priority date associated with Respondent’s International Registration (IR) no. 1469961.



13. On March 3, 2020, application serial no. 79260030 issued on the Principal Register as registration no. 5999237.

14. On information and belief, Respondent did not use the MEDABOTS mark in commerce for goods in International Class 9, namely, “providing a website featuring on-line non-downloadable music and sound files for use with consumer video game apparatus; providing a website featuring on-line non-downloadable music and sound files for use with cellular phones; providing a website featuring on-line non-downloadable music and sound files; providing a website featuring on-line non-downloadable music and sound files for use with handheld game apparatus with liquid crystal displays; providing a website featuring on-line non-downloadable music and sound files for use with video game machines; providing a website featuring on-line non-downloadable game software; providing a website featuring on-line non-downloadable game software for video game apparatus; providing a website featuring on-line non-downloadable game software for handheld game apparatus with liquid crystal displays and games for cellular phones” prior to February 28, 2018, the priority date associated with registration no. 5999237.

15. On information and belief, Respondent did not use the MEDABOTS mark in commerce for services in International Class 41, namely, “downloadable video game programs for consumer video game apparatus; downloadable video game programs for hand-held game apparatus with liquid crystal displays; downloadable video game programs for video game machines; downloadable video game programs and additional downloadable electronic data files for consumer video game apparatus; downloadable video game programs and additional downloadable electronic data files for playing games on arcade video game machines; downloadable video game programs and additional data for hand-held games with liquid crystal

displays; downloadable computer game programs and additional data for computers; downloadable video game programs and additional downloadable electronic data files for playing games on mobile phones; downloadable programs for operating mobile phones; downloadable gaming video game programs for cellular phones” prior to February 28, 2018, the priority date associated with registration no. 5999237.

16. On May 14, 2020, Petitioner filed an International Registration (IR) for its MEDABOTS mark based upon Petitioner’s pending Japanese trademark application no. 2020-028870. Petitioner has requested that protection for its pending International Registration (IR) be extended to the United States for “computers; computer peripheral devices; recorded computer programs; encoded magnetic cards; recorded computer game software; downloadable computer game software; game programs for home video game machines; electronic circuits and CD-ROMS recorded with programs for hand-held games with liquid crystal displays; phonograph records; downloadable music files; downloadable image files; recorded video discs and video tapes; application software for smartphones; downloadable applications for use with mobile devices” in International Class 9 and for “electronic games services provided by means of the Internet; information relating to electronic games services provided by means of the Internet; on-line game services provided by means of the Internet or computer network; information relating to on-line game services provided by means of the Internet or computer network; providing on-line computer games; information relating to on-line computer games; providing amusement facilities; providing on-line games for smartphones; information relating to on-line games for smartphones” in International Class 41.

17. On June 2, 2020, Petitioner filed application serial no. 88944349 with the US PTO seeking to register the mark MEDAROT for “computers; computer peripheral devices; recorded

computer programs; encoded magnetic cards; recorded computer game software; downloadable computer game software; game programs for home video game machines; electronic circuits and CD-ROMs recorded with programs for hand-held games with liquid crystal displays; phonograph records; EP records; sound recorded magnetic cards, sheets and tapes; recorded audio compact discs; downloadable music files; downloadable image files; recorded video discs and video tapes; application software for smartphones; downloadable applications for use with mobile devices” in International Class 9 and “electronic games services provided by means of the Internet; information relating to electronic games services provided by means of the Internet; on-line game services provided by means of the Internet or computer network; information relating to on-line game services provided by means of the Internet or computer network; providing on-line computer games; information relating to on-line computer games; providing amusement facilities; providing on-line games for smartphones; information relating to on-line games for smartphones” in International Class 41.

18. Application serial No. 88944339 was filed under Section 44(d) of the Trademark Act based on Petitioner’s intention to rely on the May 26, 2020 priority filing date associated with Petitioner’s pending Japanese trademark application no. 2020-065098.

19. Petitioner is and continues to be damaged by the existence of registration no. 5999237 as a result of Petitioner’s prior and ongoing use of Petitioner’s MEDAROT and MEDABOTS Marks in the United States, and in view of Petitioner’s pending application serial no. 88944349 for MEDAROT and Petitioner’s International Registration (IR) for MEDABOTS and its request to extend protection to the United States.

20. Petitioner has not abandoned Petitioner's MEDAROT mark and Petitioner continues to sell and distribute goods and render services featuring Petitioner's MEDAROT mark to consumers throughout the world, including the United States.

21. Petitioner has not abandoned Petitioner's MEDABOTS Marks and Petitioner continues to sell and distribute video game programs featuring Petitioner's MEDABOTS Marks to consumers in the United States.

22. Petitioner has established valuable consumer recognition and goodwill in Petitioner's MEDAROT and MEDABOTS Marks and, as a consequence, they have become Petitioner's identity and persona for the goods and services used in conjunction therewith in the United States.

23. MEDABOTS would be recognized as uniquely and unmistakably pointing to Petitioner, as an entity.

24. Petitioner is not connected with Registrant's activities under the MEDABOTS mark.

25. Respondent's MEDABOTS is the substantial equivalent to Petitioner's identity and persona so as to cause consumers to believe that Respondent, and the goods and services set forth in registration no. 5999237, are connected to Petitioner, when in fact they are not.

26. Petitioner's reputation is of such a nature that any use of the MEDABOTS mark by Respondent will falsely suggest a connection between Petitioner and Respondent named herein, to the damage of the Petitioner.

27. Petitioner's MEDABOTS mark is of sufficient fame or reputation that when Registrant uses MEDABOTS in connection with its goods and services, a connection with Petitioner would be presumed.

28. As a consequence, registration no, 5999237 should be cancelled pursuant to Trademark Act Section 2(a), 15 U.S.C. § 1052(a).

29. The mark set forth in registration no. 5999237 is identical in appearance to Petitioner's MEDABOTS mark and is similar in appearance to Petitioner's MEDAROT, MEDABOTS AX and MEDABOTS INFINITY marks.

30. The goods and services set forth in registration no. 5999237 are similar to the goods and services that Petitioner promotes, sells, and renders in connection with Petitioner's MEDAROT and MEDABOTS Marks.

31. The goods and services set forth in registration no. 5999237 are likely to be marketed in the same channels of trade as the goods and services offered by Petitioner under Petitioner's MEDAROT and MEDBOTS Marks.

32. The conditions surrounding the marketing of the goods and services that Petitioner offers and renders in connection with Petitioner's MEDAROT and MEDABOTS Marks and goods and services set forth in registration no. 5999237 are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and services originate from a common source.

33. Petitioner is or will be damaged by the continued existence of registration no. 5999237. Specifically, the mark set forth in registration no. 5999237 consists of or comprises a mark which so resembles Petitioner's MEDAROT and MEDABOTS Marks that a potential consumer is likely to be confused, mistaken and/or deceived as to the source of the goods and services offered by Petitioner and Respondent. As such, Petitioner requests that registration no. 5999237 be cancelled pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d).

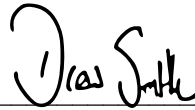
34. Petitioner's MEDAROT and MEDABOTS Marks are famous within the meaning of 15 U.S.C. § 1125(c), and have been famous prior to February 28, 2018, the date Respondent filed the application which subsequently registered as registration no. 5999237.

35. Respondent's registration no. 5999237 is therefore likely to cause the dilution of Petitioner's famous and distinctive MEDAROT and MEDABOTS Marks within the meaning of 15 U.S.C. § 1125(c) and 15 U.S.C. § 1063(a), as amended by the Trademark Dilution Revision Act of 2006.

WHEREFORE, Petitioner respectfully requests that Reg. No. 5999237 be cancelled.

Respectfully Submitted,

Imagineer Co. Ltd.



Drew M. Smith  
James R. Menker

Date: June 11, 2020

By:

Petitioner's Attorneys

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